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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,026	06/30/2003	Alan M. Zamore	2003-5	7377

26694 7590 07/10/2008
VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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07/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,026

Applicant(s)

ZAMORE, ALAN M.

Examiner

Rabon Sergent

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22, 24, 26-28 and 32-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-22, 26-28, 32, 33, 38-40 and 44-49 is/are allowed.
- 6) ☒ Claim(s) 24, 34-37 and 41-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/1/08.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 35, 37, 41, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Neil et al. ('415 or '551).

O'Neil et al. disclose the crosslinking of a thermoplastic polyamide copolymer by mixing the copolymer with an allylic crosslinking promoter and irradiating the mixture. See abstracts.

Patentees further disclose that the compositions may be used in the medical field or as insulation in the wire and cable industry. See column 4, lines 49+. Though patentees fail to disclose that the polymers are heat-shrinkable, the position is taken, given the chemical similarities between the polymers of the references and those claimed, that the disclosed polymers inherently possess heat-shrinkable properties. Furthermore, it has not been established that the claimed process steps of claim 41 yield a patentably distinct product.

3. Claims 24, 34, 36, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al. ('415 or '551) in view of Lee et al. (US 2002/0018866 A1).

O'Neil et al. disclose the crosslinking of a thermoplastic polyamide copolymer by mixing the copolymer with an allylic crosslinking promoter and irradiating the mixture. See abstracts. Patentees further disclose that the compositions may be used in the medical field or as insulation in the wire and cable industry. See column 4, lines 49+. Though patentees teach a preference for the use of PEBAX type copolymers containing polyether blocks separated by polyamide blocks, wherein the polyamide blocks are based upon nylon-11, nylon-6, or nylon-6,6, it is not seen that patentees' teachings are limited to these copolymers, and the position is further taken that one of ordinary skill in the art would have expected the disclosed method to be suitable for use with other polyamide copolymers. Accordingly, while O'Neil et al. fail to specifically disclose the use of nylon-12 segments and polyester segments within his PEBAX type copolymer, the use of PEBA and polyester containing PEBA copolymers for use in medical applications, wherein the polyamide segment is derived from nylon-12, was known at the time of invention. This position is supported by the teachings of Lee et al. at paragraphs [0022] through [0024] and [0027] through [0029]. Accordingly, the position is taken that it would have been

obvious to modify compositions that correspond to applicant's PEBA copolymer by crosslinking PEBA copolymers as disclosed by Lee et al. using the method of O'Neil et al. so as to obtain compositions suitable for medical applications having the improved characteristics taught by O'Neil et al. Furthermore, though the primary references fail to disclose that the polymers are heat-shrinkable, the position is taken, given the chemical similarities between the polymers of the references and those claimed, that the disclosed polymers would be expected to possess heat-shrinkable properties. Furthermore, it has not been established that the claimed process steps of claim 42 yield a patentably distinct product.

4. Claims 35, 37, 41, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Richards et al. ('816) or Suzuki et al. ('316) or Tobias et al. ('658) or Lenard et al. ('589).

Patentees disclose the radiation crosslinking of polyamide, wherein a polyamide is blended with an allylic monomer crosslinker and subjected to radiation. Richards et al. further disclose that the resulting compositions are useful for the production of such articles as tubing. See abstract and columns 3 and 4 within Richards et al. See abstract; column 2, lines 40+; column 3, lines 16+; and column 8, lines 41-57 within Suzuki et al. See abstract; column 2, lines 39-68; and column 3 within Lenard et al. See abstract; column 2, lines 46-68; and columns 3 and 4 within Tobias et al. Though patentees fail to disclose that the polymers are heat-shrinkable, the position is taken, given the chemical similarities between the polymers of the references and those claimed, that the disclosed polymers inherently possess heat-shrinkable properties. Furthermore, it has not been established that the claimed process steps of claim 41 yield a patentably distinct product.

4. Claims 12-22, 26-28, 32, 33, 38-40, and 44-49 are allowable with respect to the examined species of copoly(ether-ester-amide) polymer and nylon (polyamide). The remaining species of these claims remain withdrawn from consideration.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1796

R. Sergent
July 7, 2008